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REMARKS

Claims 1-15 are pending in the application. Claims 5, 10 and 15 have been withdrawn.

Claims 1-4, 6-9, and 11-14 have been rejected, and are pending.

The undersigned notes that his registration number is 39,093; the summary of the provisional election by telephone in the Office Action lists an incorrect registration number.

CLAIM REJECTIONS -- 35 U.S.C. §101

Claims 1-4, 6-9 and 11-14 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. This rejection is traversed.

The sole justification given by the Examiner for this rejection is a piecemeal analysis of one sequence of steps that the Examiner alleges would produce no tangible result. In particular, the Examiner alleges that because some test results could be discarded, the claimed process has no tangible result. The Examiner's analysis is flawed.

As clearly stated in MPEP 2106, "[o]ffice personnel must treat each claim as a whole" (emphasis added). This principle is followed in *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24." (emphasis added). As the Examiner's analysis does not consider the results of the claimed process as a whole, the rejection is improper.

Claim 1, taken as a whole, describes a method for storing test results in a database, which is clearly a tangible result and practical application. This process has an additional advantage in that test results having the same test identifiers and test result identifiers as a

previous test need not be stored, so that the results database is smaller than if a conventional process of storing every result were followed. In this way, the very step of not storing certain results has both a tangible result and a practical advantage over other methods. Such advantages are described, for example, in paragraphs 0045-0053 of the specification as filed.

The Examiner now makes an expanded argument that it is an "inevitable possibility" that a comparison between the claimed test result record and the claimed compiled test result record would result in "no matching test identifier", and that because this possibility is not explicitly addressed in Claim 1, the claim as a whole "does not provide real world results for all possible results from the comparison step." The Examiner is incorrect, again.

Claims 1, 6, and 11 addresses those embodiments where specific record modifications are made depending on whether or not the test result has changed for a given matching test identifier. In the sort of real-world example the Examiner appears to require, if only the same set of tests a re-run, then there will is no "inevitable possibility" that there will be no matching test identifier, and every comparison will result in either a modification of a record, in the event of different results, or no modification, in the case of matching results. This provides advantages as described above.

There is no legal requirement at all that these claims be drawn to narrower embodiments.

Dependent claims 3-4, 8-9, and 13-14 address other embodiments in which additional or new tests are run, as described in the specification, so that there is no matching test identifier. When this is the case, new records are created. As described in the specification,

this function can be performed separately from the initial comparisons, and this function is claimed as a further limitation to the respective independent claims.

Even according to the Examiner's flawed analysis, these dependent claims address the very possibility that the Examiner complains is missing from the independent claims. As can be seen, even using the Examiner's logic, claims 3-4, 8-9, and 13-14 should be completely allowable over the §101 rejection.

The rejection of independent claims 1, 6, and 11, and their dependent claims 2-4, 7-9, and 12-14, are traversed. Independent claims 5, 10, and 15 have similar tangible results and similar practical application, and so are similarly statutory subject matter.

The Examiner makes the statement that "The claim does not provide a tangible result for all possible results from the comparison step." This statement is incorrect, as described above, but also is not a requirement for patentability. The Examiner has been requested one to cite any statutory or common-law basis for this novel "all possible results" test. The Examiner has failed to do so, certainly because there is no such legal requirement.

The Examiner is lauded for her dedication to the USPTO "Patent Goals", which of course carry no legal weight whatsoever, and her efforts to streamline the patent process and close the prosecution of a case faster. With these goals in mind, if the Examiner intends to maintain her baseless rejection, and in light of the fact that there is no rejection over prior art at all, she is respectfully requested to issue her Advisory Action as soon as possible so that this case can proceed promptly to appeal.

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CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***manderson@munckbutrus.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS P.C.

Date: 12/12/6

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